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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,926	12/26/2001	Hidehiko Yokoyama	35.C16078	7398

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EXAMINER

DALEY, CHRISTOPHER ANTHONY

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/025,926	Applicant(s) YOKOYAMA, HIDEHIKO	
	Examiner Christopher A. Daley	Art Unit 2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-25, 40, 44 and 59-64 is/are pending in the application.
 4a) Of the above claim(s) 6-8, 26-39, 41-43 and 45-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-25, 40, 44 and 59-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 5, 9 – 25, 40, 44, 59 – 64 are pending.
2. Claims 6 – 8, 26 – 39, 41- 43, 45 – 58 are cancelled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 – 5, 9-10, 12-25, 40, 44, 59-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Smethers (US6560640).
5. As to claim 1, 25, 44, and 63 Smethers discloses a communication apparatus, method, and medium comprising:

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A communication unit adapted to transmit data to a designated destination, a management unit adapted to manage ID information determined for each user and address location information associated with the ID information wherein the address location information indicates a location that stores address information for designating the destination to transmit the data by said communication unit; (Smethers teaches of a communication unit as shown in figure 1, that comprises of communication unit 100 of figure 1 transmitting data to management unit 116 over airnet 112. Management unit 116 is a proxy server that comprises address location information associated with the ID information provided by the communication unit 100. The address location points to a web site on web server 124 that can transmit data to communication unit 100, COL. 5, line 60 – COL. 6, line 29)

an input unit with which the user inputs the ID information; (Smethers teaches of input device 100 of figure 1 that can be used to input ID information, COL. 6, lines 39 - 49)

and

an obtaining unit adapted to specify the address location information managed by said management unit based on the inputted ID information, communicate with an external apparatus via a network based on the address location information, and obtain the address information residing at the external apparatus corresponding to the location specified by the address location information wherein said communication unit transmits the data to the destination designated from the address information obtained by said obtaining unit. (Smethers teaches in figure 3 of an obtaining unit 344 that is used to store the ID information and to interface with the external device through LCP interface 348)

6. As to claim 2, Smethers discloses a communication apparatus, further comprising a display unit adapted to display the address information obtained by the obtaining means. (Smethers teaches in figure 1 of personal computer 128, comprising a monitor that can display the address information).

7. As to claim 3, Smethers discloses a communication apparatus, wherein the display unit separately displays address information possessed by the communication apparatus advance and the address information obtained from the external apparatus. (Smethers teaches of the use of an internet browser in unit 128 of figure 1, which would display both information, COL. 5, line 60 – COL. 6, line 5).

8. As to claim 4, Smethers discloses a communication apparatus, wherein the display unit displays address information possessed by the communication apparatus in advance and the address information obtained from the external apparatus at the same time by combining the possessed address information and the obtained address information. (Smethers teaches of the use of a internet browser in unit 128 of figure 1, which would display both information, COL. 5, line 60 – COL. 6, line 5).

9. As to claim 5, Smethers discloses a communication apparatus, further comprising a selection unit adapted to select a desired destination candidate from the address information displayed by the display means unit. (Smethers teaches of using the HTTP address to access the information server 124 in figure 1, COL. 6, lines 2 – 5).

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10. As to claims 9 and 22, Smethers discloses a communication apparatus , wherein the address information is address information converted by the external apparatus into a data format that is usable at the communication apparatus. (Smethers teaches of converting the address expressed in handheld device (100)-transport protocol (HDTP) to the server (124) protocol of HTTP, COL. 6, lines 29 – 49).

11. As to claims 10,19, and 20,23,24,60, 61, and 62 Smethers discloses a communication apparatus, program, and transfer, wherein the address information is data written in an XML language. (Smethers teaches of using HTTP, HTML, which is a XML language, COL. 7, lines 6 - 14).

12. As to claim 12, Smethers discloses a communication apparatus a control unit adopted to control the obtaining means unit and the management unit, wherein when in a case where the ID information is inputted with the input unit, the control means unit judges whether or not it is required to obtain the address information based on a predetermined condition. (Smethers teaches of a control unit processor 340 of figure 3, which is coupled to the input unit through interface 304. This unit would check the predetermined assigned key, COL. 11, lines 34 – 51).

13. As to claim 13, Smethers discloses a communication apparatus, wherein the predetermined condition is timing information that determines intervals between

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operations for obtaining the address information. (Smethers teaches that should a previously assigned key, the time taken to retrieve said information would be less, as no set up would be involved, as outlined in COL. 11, lines 18 – 32. Instead, the already available bookmark guides the user to the destination, COL. 11, lines 50 – 56).

14. As to claim 14, Smethers discloses a communication apparatus , wherein it is possible to define the timing information for each user managed by the management means unit. (Smethers teaches of including shortcuts and assigning the bookmarks to the keys done by the management unit, which would define the timing information, COL. 11, lines 40 – 56).

15. As to claim 15, Smethers discloses an update adapted to forcibly obtaining the address information even in a case where the obtaining means unit is controlled by the control means unit based on the predetermined condition so as not to obtain the address information even if the ID information is inputted. (Smethers teaches in figure 2 of laptop computer 270 coupled to proxy server that comprises said address though landnet 260, which provides an alternative path to obtain said address, COL. 8, lines 60 – 65).

16. As to claim 16, Smethers discloses a communication apparatus , wherein the management unit manages the ID information and

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the address location information by utilizing a nonvolatile storage medium. (Smethers teaches that said storage medium is in a server that is well known in the art to comprise nonvolatile memory).

17. As to claim 17,21,40,59, and 64 Smethers discloses a communication apparatus, method, program, and medium capable of communicating with an external apparatus via a network, comprising:

a communication unit adapted to transmit data to a designated destination a management unit adapted to manage address information for designating the destination to transmit the data by said communication unit;(Smethers teaches of a communication unit comprising of a terminal 100 in figure 1 transmitting data to a management unit, server 116 of figure 1, that manages addresses for server 124 to transmit data, COL. 5, line 60 – COL. 6, line 11)

a reception unit adapted to receive, from the external apparatus via the network, a request to obtain the address information managed by the management means unit; (Smethers teaches of WCP interface 304 of figure 3, that receives a request via the airnet (310) network, COL. 11, lines 9 – 14)

and a transfer unit adapted to transfer the address information to the external apparatus, which has requested the address information, based on the request.(Smethers teaches of a transfer unit, LCP interface 348 of figure 3 that retrieves said information, COL. 11, lines 34 – 40).

18. As to claim 18, Smethers discloses a communication apparatus

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, further comprising a data conversion unit adapted to convert based on the request received by the reception means unit, the address information managed by the management means unit into a data format usable at the external apparatus. (Smethers teaches of a processor 324 comprising a data conversion unit 332 in figure 3 that converts the address information, COL. 11 lines 15 – 17).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smethers.

21. As to claim 11, Smethers does not explicitly disclose a communication apparatus, further comprising an authentication unit adapted to authenticate the user based on the ID information input by the input means unit and the information managed by the management means unit. (It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an information checker to realize a quality product for the marketplace).

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Daley whose telephone number is 571 272 3625. The examiner can normally be reached on 9 am. - 4p m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 571 272 3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CAD
4/26/2005

TIM VO
PRIMARY EXAMINER